APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,611	12/21/1999	ERIC B. REMER	42390.P7278	3835

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EXAMINER
HAYES, JOHN W

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 07/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Office Action Summary	09/468,611	REMER ET AL.
	Examiner	Art Unit	
	John W Hayes	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 1999* .

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 December 1999* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

1.   The disclosure is objected to because of the following informalities:

The disclosure is objected to because it contains an embedded hyperlink and/or other form of

browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of

browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the

rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA)

do not apply to the examination of this application as the application being examined was not (1) filed on

or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this

application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C.

102(e)).

3.   Claims 1-6, 8-18, 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Misra et al, U.S.

Patent No. 6,189,146 B1.

As per **Claims 1 and 13**, Misra et al discloses a method for licensing software comprising:

- generating on a first computer a first license for software installed on the first computer (Col. 2,

lines 62-67; Col. 3, lines 22-25; Col. 11, lines 45-51; Col. 12, lines 8-14)

- generating on a second computer a second license for the installed software (Col. 2, lines 48-55; Col. 8, lines 35-67; Col. 9, lines 29-36; Col. 13, lines 61-63)

- obtaining from the second computer the second license as authorized by the second computer (Col. 4, lines 54-59; Col. 12, lines 20-27; Col. 14, lines 8-14 and 49-53)

- conditionally replacing the first license with the second license (Col. 16, lines 49-67)

- periodically repeating the obtaining and replacing so that the first computer remains licensed each time the first computer submits a connection request and when it is determined that the license on the first computer is expired or an older version (Col. 14, lines 14-51; Col. 16, lines 49-67).

As per **Claim 2**, Misra et al further disclose wherein the first and second licenses each share a unique identifier, the unique identifier associating the first and second licenses with the first computer (Col. 9, lines 29-61; Col. 10, lines 51-59; Col. 12, lines 47-67)

As per **Claims 3 and 10**, Misra et al further disclose wherein the first and second licenses are digitally signed (Col. 13, lines 42-63; Col. 14, lines 25-38).

As per **Claim 4**, Misra et al further disclose wherein obtaining further comprises:

- connecting to the second computer (Col. 14, lines 14-16)

- providing the second computer with at least some or all of the data from the first license (Col. 14, lines 24-30)

- exchanging the provided data from the first license for the second license (Col. 14, lines 49-53; Col. 15, lines 11-18 and 37-49).

As per **Claims 5-6**, Misra et al further disclose wherein connecting to the second computer is performed using a communications network (Col. 4, lines 43-49).

As per **Claim 8**, Misra et al further discloses wherein conditionally replacing further comprises:

- matching the unique identifier of the second license to the unique identifier of the first license,

and if not matched discarding the second license without replacing the first license (Col. 11, lines

45-65; Col. 11 line 66-Col. 12 line 7; Col. 14, lines 30-39), and

- authenticating the digital signature of the second license, and if not authentic discarding the

second license without replacing the first license (Col. 12, lines 8-15).

As per **Claim 9**, Misra et al disclose verifying whether the replaced license is valid, including

determining whether the replaced license has expired (Col. 14, lines 30-48).

As per **Claim 11**, Misra et al further disclose a licensing service comprising:

- an enforcement agent to control the licensing for an installed software on a device (Figure 3,

32)

- a license issuer to issue licenses for the installed software (Figure 3, 26)

- a service agent, in communication with the enforcement agent and the license issuer, to

distribute licenses from the license issuer to the device (Figure 3, 28)

As per **Claim 12**, Misra et al disclose a license provider comprising:

- a license authorizer to authorize the issue of licenses for software installed on remote devices

(Figure 3, 28)

- a license issuer to issue the authorized licenses (Figure 3, 26)

- a license distributor to distribute the issued authorized licenses to the remote devices (Figure 3,

32)

- a license enforcer to prevent the operation of the installed software on the remote device

without an authorized license (Figure 3, 32)

As per **Claims 14-15**, Misra et al further disclose wherein the enforcement agent determines if

the license distributed to the device is valid by:

- verifying that the license is present on the device (Col. 14, lines 14-31),

- verifying that the license is current (Col. 14, lines 42-48),

- verifying that the license is digitally signed and that the digital signature is authentic (Col. 14,

lines 30-35); and

- disables the device's installed software if the license is not valid (Col. 14, lines 39-42).

As per **Claims 16 and 17**, Misra et al further disclose wherein the digital signature is authentic

when a message digest algorithm applied to a portion of the license results in a calculated message

digest that is the same as the message digest in the license and further verifying that the message digest

in the license is properly encrypted using a binary key extracted from a unique identifier in the license

(Col. 15 line 55-Col. 16 line 37).

As per **Claim 18**, Misra et al further disclose wherein the communication between the

enforcement agent, license server, and service agent is performed using the Internet (Col. 4, lines 43-49).

As per **Claim 20**, Misra et al further disclose wherein the license issuer resides on a computer

that communicates with the service agent over a wide area network, and the service agent resides on a

computer that communicates with the device over a local area network (Figure 3, Col. 4, lines 42-49; Col.

6, lines 17-20).

As per **Claim 21**, Misra et al further disclose wherein the distribution of licenses by the service

agent comprises:

- matching a unique identifier on the distributed license with a unique identifier on an existing

license on the device (Col. 11, lines 45-65; Col. 11 line 66-Col. 12 line 7; Col. 14, lines 30-39)

- replacing the existing license with the distributed license when the unique identifiers match, the

distributed license is current, the distributed license is digitally signed and the digital signature is

authentic otherwise discarding the distributed license and retaining the existing license (Col. 14, lines 14-51; Col. 16, lines 39-67).

As per **Claims 22-24**, Misra et al disclose a method for preventing piracy of installed software comprising:

- generating on a device a non-renewable license that is of limited duration, the non-renewable license having a unique identifier that associates the license with the device on which the software is installed, and a digital signature (Col. 11, lines 45-51; Col. 11 line 65-Col. 12 line 14),

- periodically replacing the non-renewable license with a purchased non-renewable license of limited duration, the purchased license having a matching unique identifier and a matching digital signature, the purchased license generator on a computer capable of communication with the device (Col. 14, lines 2-53; Col. 15, lines 9-49; Col. 16, lines 38-67).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al, U.S. Patent No. 6,189,146 B1.

As per **Claim 7,** Misra et al disclose all the limitations of claim 5, however, fail to specifically disclose wherein exchanging includes formatting the data from the first license using XML and exchanging the formatted data using the HTTP protocol. Examiner takes Official Notice that formatting data using XML format and exchanging data using the HTTP protocol was well known in the art at the time of applicants invention. Thus, it would have been obvious to one of ordinary skill in the art at the

time of applicant's invention to use the XML format for formatting data and use the HTTP protocol for

exchanging data since these formats and protocols were commonly used, especially in Internet

communications since they were readily available and convenient to use.

As per **Claim 19**, Misra et al disclose all the limitations of claim 11 and further disclose an

enforcement agent, however, fail to specifically disclose wherein the enforcement agent resides on the

device. However, it would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to arrange the user device so that the enforcement agent was integrated with the device, since

it has been held that rearranging or shifting the location of parts of an invention involves only routine skill

in the art, *In re Japikse*, 86 USPQ 70, 73; 182 F2d 207 (CCPA 1950), and since it has been held that the

use of a one piece construction instead of a structure including separate parts would be merely a matter

of obvious engineering choice and not patentable. *In re Larson*, 144 USPQ 347, 349; 339 US 965 (CCPA

1965); *In re Wolf*, 116 USPQ 443, 444; 251 F2d 854 (CCPA 1958).

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

o Ross et al disclose a method and apparatus for electronic licensing in a network environment to

facilitate product licensing and upgrades

o Coley et al disclose an automated system for management of licensed software and enabling or

disabling the software accordingly

o Griswold discloses a license management system that periodically invokes a license check monitor to

ensure valid usage of software and terminates use of the software is appropriate

o Horstmann discloses a method of relicensing of electronically purchased software

o Knutson discloses a method for licensing computer programs using DSA signature

o Carter et al disclose a method for network license authentication

o Cohen discloses a method for software licensing electronically distributed programs
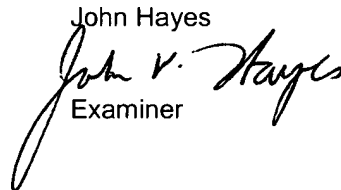
7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

   The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-5531 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

   The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-7687 (for formal communications intended for entry including After-Final communications).

   Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

John Hayes

Examiner

28 June 2002